

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

----- X
ITOFFEE R. GAYLE

Plaintiff,

v.

HOME BOX OFFICE, INC, RACHEL STROM,
ADAM LAZIER, and STEVE SAPIENZA

Defendants.
----- X

Case No. 17-cv-5867 (JMF)

DECLARATION OF RACHEL F. STROM

I, Rachel F. Strom, declare as follows:

1. I am a partner at Davis Wright Tremaine LLP, counsel to Defendants in this action. I submit this declaration in support of Defendant Home Box Office, Inc.'s ("HBO") Motion to Dismiss the Amended Complaint in this action. I am familiar with the facts herein and make this declaration from my own personal knowledge.

2. Attached hereto as Exhibit "A" is a DVD containing a true and correct copy of Episode 5 of Season 1 of the television show *Vinyl*.

3. Attached hereto as Exhibit "B" is a true and correct copy of an April 23, 2017 letter from Plaintiff's then-counsel to HBO, including all enclosures.

4. Attached hereto as Exhibit "C" is a true and correct copy of an April 28, 2017 email from Plaintiff's then-counsel to HBO, including the attachment to that email.

5. I personally searched the U.S. Copyright Office's online Public Copyright Registration Catalog for copyright registrations held by Plaintiff Itoffee Gayle. I only found one registration, which was the one provided with the letter from Plaintiff's former counsel. *See*

Exhibit B. According to Plaintiff's then-counsel, that copyright registration does not cover the specific graffiti that is at issue in this litigation. *Id.*

I declare under penalty of perjury that the foregoing is true and correct.

Executed on: September 15, 2017

/s/ Rachel F. Strom
Rachel F. Strom

EXHIBIT A

A DVD containing a true and correct copy of Episode 5 of Season 1 of the television show *Vinyl* was served on Plaintiff and will be submitted to the Court along with courtesy copies of all motion papers pursuant to Rule 4(D) of the Court's Individual Rules and Practices in Civil *Pro Se* Cases.

EXHIBIT B



April 23, 2017

Home Box Office, Inc.
Attn: Judith McCool
1100 Avenue of the Americas
New York, NY 10036
trademarks@hbo.com

Dear Ms. McCool:

We are contacting you on behalf of our Client, Itoffee Gayle.

Mr. Gayle is the owner of U.S. Trademark Registration 5108721 for the mark ART WE ALL. He is also owner of Copyright Registration No. VA 2006958 for the works of art attached hereto. This trademark and the copyrighted images possess significant goodwill and are of great value to our Client and his reputation as an artist and business person.

It has been brought to our Client's attention that Home Box Office, Inc (HBO), used the trademark, ART WE ALL, along with the original works of art of the copyright registration in an episode of your series entitled "Vinyl" without permission or consent. Specifically, Season 1, Episode 5 at 49:38. Mr. Gayle has the exclusive right to copy, distribute, make derivative works of, publicly display and license his copyrighted materials and trademark. Your company has not been given permission to use his intellectual property.

Your use of our Client's intellectual property may cause substantial monetary and reputational harm to our Client. Indeed, your unauthorized use of the trademark and works of art or a derivation thereof constitutes among other things, (i) federal trademark infringement under 15 U.S.C. §1114(a); (ii) federal unfair competition under 15 U.S.C. §1125(a); and/or (iii) unfair competition and trademark infringement under related state laws as well as copyright infringement which may include an award of profits for each act of infringement, statutory damages, as well as attorneys' fees and costs under 17 U.S.C. §504 et seq.

Accordingly, we demand that you immediately and permanently cease all use of the copyrighted images and the trademark, ART WE ALL, or any derivations thereof.

Further, Mr. Gayle will require an appropriate monetary payment, the amount to be determined, to compensate him for the damages caused as a result of your unauthorized activity.

Please acknowledge receipt of this letter within ten (10) business days with a statement indicating your company's intentions regarding the demands made herein.

It is our hope to resolve this matter amicably; however, we can assure you that we take this matter very seriously and in the absence of your compliance with our above demands, we will take all actions necessary to protect the rights of Mr. Gayle.

The statements set forth in this letter are not intended to be a full and complete statement of the facts in this matter. This letter is not intended to be a complete statement of our rights and shall not be construed as a waiver of any legal or equitable rights or remedies, all which are expressly reserved.

Sincerely,
/Laurie Marshall/
Laurie Marshall, Esq.

United States of America

United States Patent and Trademark Office

ART WE ALL

Reg. No. 5,108,721

Registered Dec. 27, 2016

Int. Cl.: 35

Service Mark

Principal Register

Gayle, Itoffee (UNITED STATES INDIVIDUAL)
2010 Powell Ave Apt 2F
Bronx, NY 10472

CLASS 35: Retail store services featuring works of art

FIRST USE 4-27-2016; IN COMMERCE 4-27-2016

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 87-032,634, FILED 05-11-2016
STEPHANIE DIA RYDLAND, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

Registration Number

VA 2-006-958

Effective Date of Registration:

March 25, 2016

Maria A. Pallante

United States Register of Copyrights and Director

Title

Title of Work: Art We All

Completion/Publication

Year of Completion: 2012

Date of 1st Publication: January 01, 2012

Nation of 1st Publication: United States

Author

- **Author:** Itoffee Gayle
- Author Created:** photograph
- Citizen of:** United States

Copyright Claimant

Copyright Claimant: Itoffee Gayle
2010 Powell Ave., Bronx, NY, 10472, United States

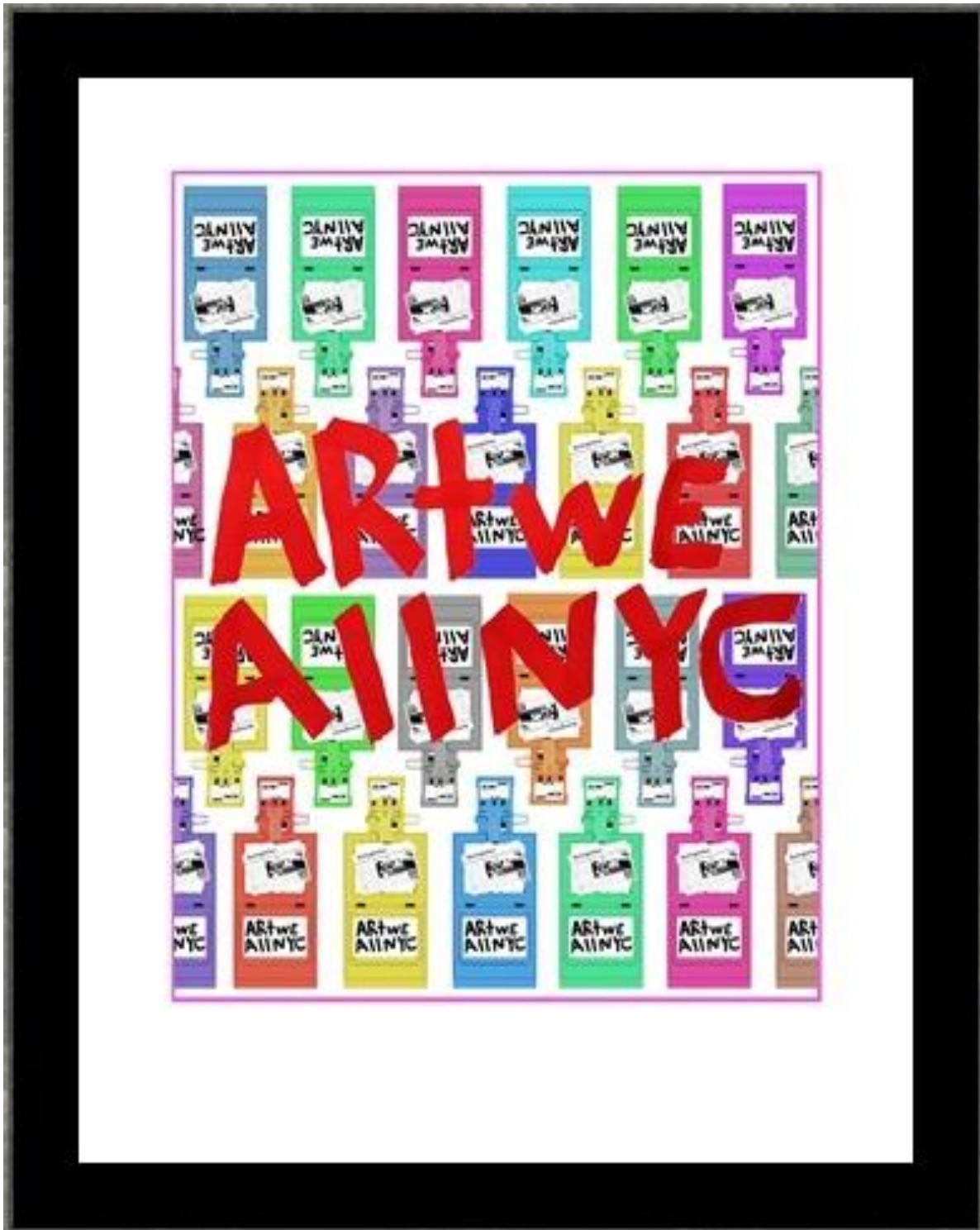
Rights and Permissions

Name: Itoffee Gayle
Email: representart1@gmail.com
Telephone: (917)952-5661

Certification

Name: Itoffee Gayle
Date: March 25, 2016

ART WE ALL NYC



ART WE ALL NYC



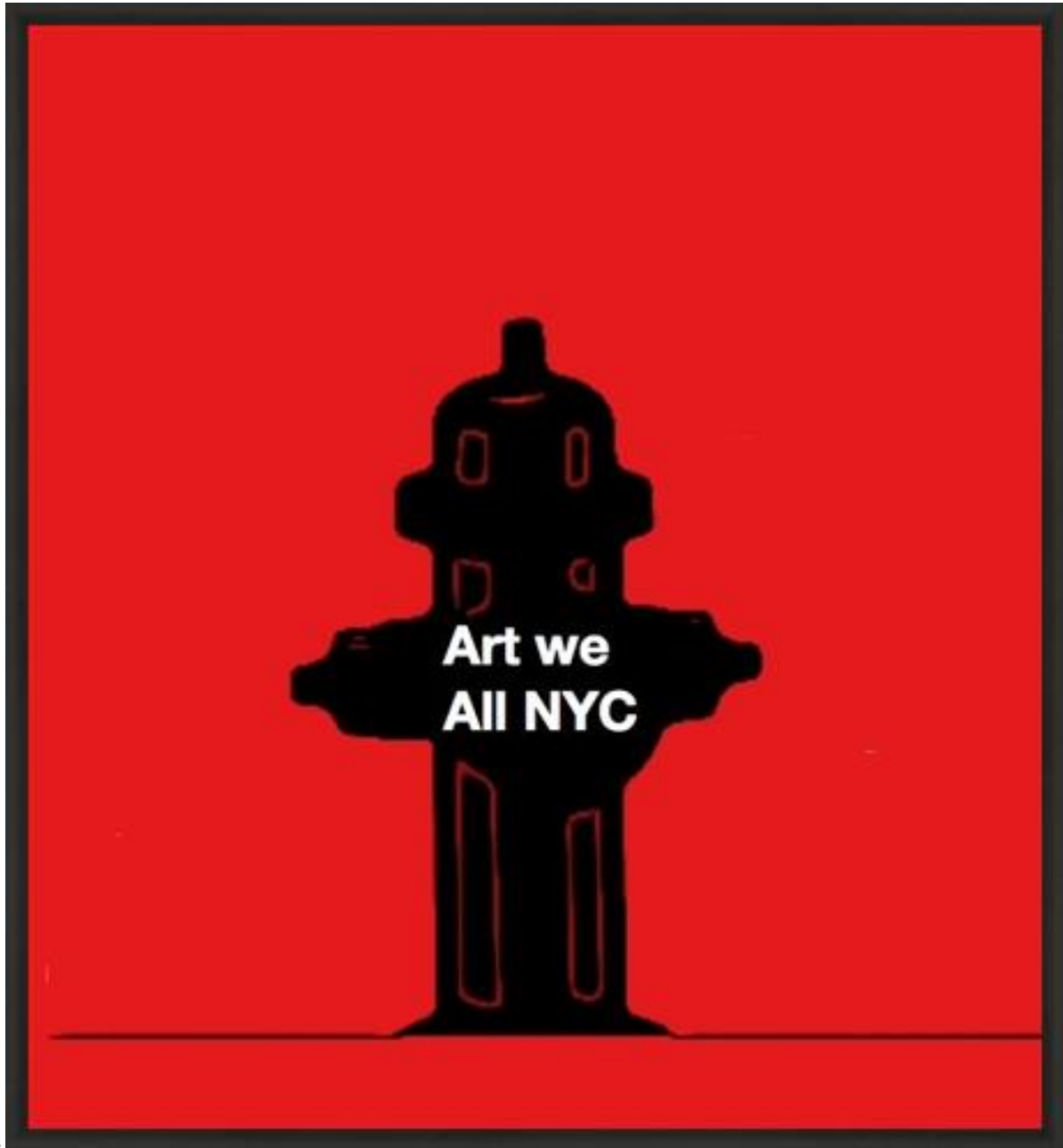
ART WE ALL NYC



ART WE ALL NYC



ART WE ALL NYC



ART WE ALL NYC



Registration #: VA0002006958
Service Request #: 1-3241517994

Direct Incorporation
Edward Stahlin
315 W Huron St Suite 240
Ann Arbor, MI 48103 United States

EXHIBIT C

From: legal@tmthespot.com [<mailto:legal@tmthespot.com>]
Sent: Friday, April 28, 2017 4:02 PM
To: Sapienza, Steve (HBO) <Steve.Sapienza@hbo.com>; laurie@tmthespot.com
Cc: artseenone@gmail.com; itoffeegayle@yahoo.com
Subject: Re: Vinyl

Dear Mr. Sapienza: Thank you for your quick response. Attached are screenshots from the episode mentioned in our email.

Please contact Mr. Gayle directly for further requests and discussions - his emails are shown in the copy line above.

Thank you.

Please note: The U.S. trademark office is conducting an extensive upgrade the weekend of April 29-30. This upgrade will render all outstanding applications which have not been officially submitted as obsolete. This means we will have to re-draft any applications not signed or for which you have not submitted credit card information. If you have an outstanding application, please make sure we receive it no later than Thursday, April 27. As a precaution, we will not be drafting any applications between Thursday, April 27-Monday, May 1. We apologize for any inconvenience this may cause and appreciate your patience at the USPTO makes their updates.

Best regards,

Cate Larson
Paralegal

www.tmthespot.com

legal@tmthespot.com - Please "reply all" if you are responding to this email to keep our entire team updated.

Phone: 847-856-9799

Mailing address: 562 West End Avenue, Suite 4A, New York, NY 10024

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attachment for any purpose, nor disclose all or any part of the contents to any other person.
Thank you.

Begin forwarded message:

From: "Sapienza, Steve (HBO)" <Steve.Sapienza@hbo.com>
Subject: Vinyl
Date: April 27, 2017 at 10:16:31 AM EDT
To: "laurie@tmthspot.com" <laurie@tmthspot.com>

Laurie Marshall, Esq.
Marshall Law Group

Dear Ms. Marshall,

HBO is in receipt of your email correspondence dated April 23, 2017 regarding the HBO series, *Vinyl*. I have been asked to respond. However, I am unable to locate the content that you assert appears at 49:38 of episode 5 of the Series. Perhaps you can clarify this reference.

I write without prejudice to HBO's rights, remedies and defenses, all of which are expressly reserved.

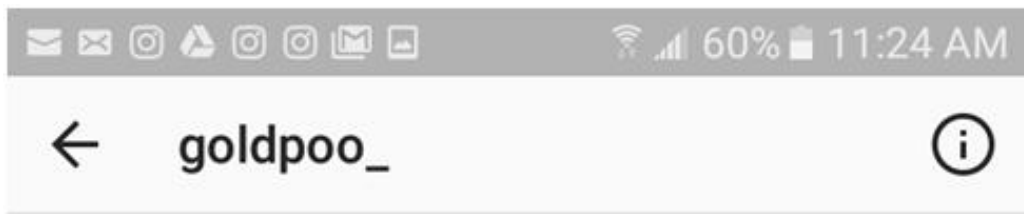
Very truly yours,

Steve Sapienza

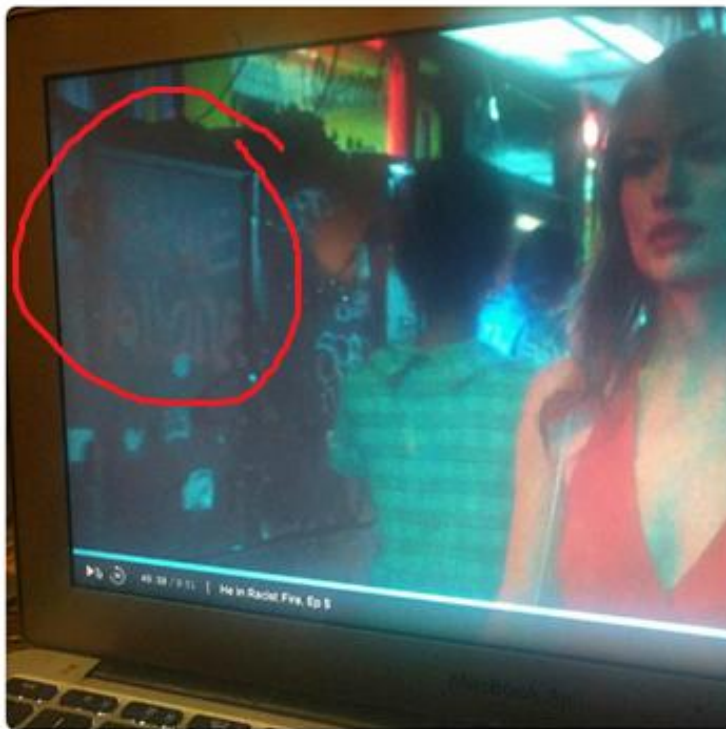
Stephen L. Sapienza
Vice-President and Senior Counsel - Litigation
Home Box Office, Inc.
1100 Avenue of the Americas
New York, NY 10036
(212) 512-1680 (office)
(212) 512-1986 (fax)
(347) 268-6732 (cell)

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Mar 14, 6:56 PM



Vinyl S01E05 49:38



Congrats bud



Write a message...



ORIGINAL ARTWORK ON W125th St/ST. NICHOLAS AVE



tls_sp

Follow



♥ 25 likes

tls_sp mop flow @artweallone #spaz #artweallone
#drip #drippy #drips #nobuff #mailboxes #drip
#drips #drippy #spaz #stateyourname ... more

witnessthefitnessaus 👍

SEPTEMBER 3, 2015





ORIGINAL
ARTWORK ON
W125th St/ST.
NICHOLAS
AVE



♥ 51 likes

artweallone #artweall #artweallone #artweallnyc

View all 5 comments

facemaskxx @artweallone Boy u on a tear

ignitedesigns You are everywhere, big ups
@artweallone

NOVEMBER 19, 2015

